

08/117,363



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HOLEMAN'S

JOSEPH LUCCI
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ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

1807

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DATE MAILED

04/08/96

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 3 mo. or continues to run 3 mo. from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed _____ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☒ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The newly presented limitation "x is about 1 to about 50" raises new issues under §112, 1st paragraph. It must be re-evaluated whether these relatively smaller side groups are enabled within by the spec. Also, support for "1 to about 50" was not found where indicated by "1 to about 20" or "20 to about 150" or "10 to about 50". The spec. suggests that 1 to 10 is not preferred, while the new claims suggest that 1-10 is as preferred as 10 to 50.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: None
Claims objected to: None
Claims rejected: 1-29

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because they are made in view of non-entry of the amendment.
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
☐ Other

Mindy B. Fleisher
MINDY FLEISHER
SUPERVISORY PATENT EXAMINER
GFE--

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3-25-96
PTOL-303 (REV. 5-89)

15. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I. Claims 1-29, drawn to linked nucleosides, classified in Class 536, subclass 24.5.

Group II. Claims 30-31, drawn to methods for modulating protein production, classified in Class 435, subclass 69.1.

Group III. Claims 32-33, drawn to methods of treatment, classified in Class 514, subclass 44.

Group IV. Claims 34-35, drawn to methods of detection, classified in Class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

16. The Group I linked nucleosides and the Groups II-IV methods are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In this case the nucleosides can be used with an affinity column in methods of purification of complementary DNA sequences or in any of the methods of group II-IV.

17. The methods of groups II-IV are distinct. These methods have different reagents, different steps and result in different end products.

18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

19. A telephone call was made to Mr. Lucci on 6/23/94 to request an oral election to the above restriction requirement, but did not result in an election being made.

20. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

22. Papers relating to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CMI Fax center numbers are (703) 305-3014 or (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner

Serial No. 08/117,363
Art Unit 1807

-4-

can normally be reached on Tuesday-Friday from 8:30 AM - 6:00 PM.
The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Margaret Parr, can be reached at (703) 308-2454.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Scott Houtteman

Scott Houtteman
July 26, 1994

M. Parr 8/30/94
MARGARET PARR
SUPERVISORY PATENT EXAMINER
GROUP 1800